REMARKS

Introduction

Applicants adopt prior arguments of distinction over Ogawa '874 set forth in the appeal brief.

Rejection Under 35 U.S.C. §112

The examiner rejected claims 1-11 under 35 USC §112, second paragraph, as being indefinite because they merely recited "a method." Although applicants disagree with the examiner's reasoning, applicants amend these claims to recite a "computer-implemented method" since deployment in a computer was the original intent of the inventors. The claims, as originally cast, inherently are limited to computer application by virtue of reciting "stored file formats" and "data file." These elements do not exist in the abstract or outside a computer environment.

Rejection Under 35 USC §101

The examiner also rejected claims 1-11 as being non-statutory under 35 USC §101 purportedly because they produce no tangible result outside a computer or are not limited to a practical application within the technological arts. Applicants believe the rejection is unwarranted since the original claims clearly has application in the data processing arts, i.e., by recited a "data file" and "file formats;" and clearly produces a tangible result, i.e., providing a more efficient format translation of a desired file. Nevertheless, applicants amended the claims to recited a "computer-implemented" method. Applicants further amended the claims in question to recite "providing the requested file format to a user," which further characterizes a tangible result produced by the invention.

Rejection Under 35 USC §103(a)

All claims 1-23 now stand rejected as being unpatentable over Ogawa '874 in view of what the examiner incorrectly deems as admitted prior art. Here, the examiner concedes that Ogawa '874 fails to disclose determining an *optimal* file format from which to begin a translation to a requested file format. But according to the examiner, Ogawa's deficiency is met

by the disclosure contained at page 3, second paragraph, of applicants' own specification. The passage relied upon, in entirety, provides:

> **Since it may often be the case that a requested data file exists within an enterprise in many different formats other than the requested format, a further advantageous aspect of the transcoding scheme would provide logic for selecting the *optimal version* of a requested data file from which to perform the translation. [italics added]**

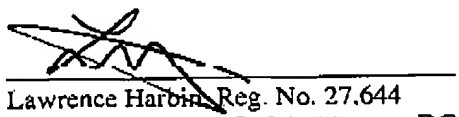
In light of this disclosure, the examiner contends that applicants inherently admit that determining or selecting an *optimal* one of plural file formats from which to begin a translation constitutes admitted prior art. The examiner argues that the admitted prior art "discloses a requested data file exists ... in many different formats other than the requested format, ... for selecting the *optimal version* of a requested data file from which to perform the translation."

In rebuttal, the examiner clearly misconstrues applicants' disclosure. While the passage relied upon provides that the *transcoding scheme* provides for selecting an *optimal file format* from which to begin a translation, the immediately preceding sentence states this to be the problem solved or objective provided by the present invention, to wit: "there is a need to provide a seamless data format ... *transcoding scheme* to further improve inter-enterprise data exchange." Thus, the "transcoding scheme" referred to in the examiner-quoted passage (which provides for selecting an optimal version) is not an "admission" but clearly refers back to the "transcoding scheme" of the preceding sentence. The quoted passage does not characterize a pre-existing system or scheme.

The examiner cannot lawfully use applicants' statement of the invention as prior art.

Thus, reconsideration is requested.

Respectfully submitted,
McINTYRE HARBIN & KING



Lawrence Harbin, Reg. No. 27,644
500 Ninth Street, S.E., Washington, DC 20003
202.546-1100 tel. 202.543.9230 fax

Substitute Claims

1. (Currently Amended) A computer-implemented method for selecting a file format from a plurality of stored file formats for use in performing a translation from a selected file format to a requested file format, the method comprising the steps of:

receiving a request for a data file in a requested format;

determining an optimal file format of said data file from a plurality of stored file formats of said data file for use in performing said translation to said requested file format; ~~and~~

translating the optimal file format of said data file determined in said determining step to the requested file ~~format~~ format, and

providing the requested file format to a user.

2. (Previously Presented) The method according to claim 1 wherein said determining step is based upon minimizing data loss from said translation.

3. (Previously Presented) The method according to claim 1 wherein said determining step is based upon minimizing the file size of the translated data file.

4. (Previously Presented) The method according to claim 1 wherein said determining step is based upon the requested file format and available stored file formats.

5. (Previously Presented) The method according to claim 1 wherein said determining step further includes the step of consulting an optimized list of file formats from which to perform said translation of said stored data file to the requested file format.

6. (Previously Presented) The method according to claim 5 wherein said list is indexed by said requested file format.

7. (Previously Presented) The method according to claim 5 wherein said optimized list is consulted if the data file is stored in a plurality of formats.

8. (Previously Presented) The method according to claim 5 wherein said consulting step further includes selecting one of said optimized list from a plurality of said optimized lists.

9. (Previously Presented) The method according to claim 8 wherein ordering of said optimized lists is based on criterion regarding the translation to be performed on the stored data file.

10. (Previously Presented) The method according to claim 9 wherein said criterion is defined by a received request for said data file.

11. (Previously Presented) The method according to claim 6 further comprising the steps of:

accessing a portion of said optimized list ordered based upon the requested file format;

determining whether one or more of said listed file formats exists as one of said stored file formats; and

selecting from said optimized list the optimal file format that is determined to exist as a stored file format.

12. (Previously Presented) A program storage device readable by a digital processing apparatus and tangibly embodying a program of instructions executable by the digital processing apparatus to perform method steps for selecting a file format from a plurality of stored file formats for use in performing a translation from said selected file format to a requested file format, the method comprising the steps of:

receiving a request for a data file in a requested file format; and

determining an optimal file format from a plurality of stored file formats of said data file for use in performing said translation to said requested file format.

13. (Previously Presented) The program storage device according to claim 12 wherein said determining step is based upon minimizing data loss from said translation.

14. (Previously Presented) The program storage device according to claim 12 wherein said determining step is based upon minimizing the file size of translation of said data file.

15. (Previously Presented) The program storage device according to claim 12 wherein said determining step is based upon the requested file format and the available stored file formats.

16. (Previously Presented) The program storage device according to claim 12 wherein said determining step further includes the step of consulting an optimized list of file formats from which to perform said translation of said stored data file to the requested file format.

17. (Previously Presented) The program storage device according to claim 16 wherein said list is indexed by said requested file format.

18. (Previously Presented) The program storage device according to claim 16 wherein said optimized list is consulted if the stored data file is stored in a plurality of formats.

19. (Previously Presented) The program storage device according to claim 16 wherein the consulting step further includes selecting one or said optimized lists from a plurality of said optimized lists.

20. (Previously Presented) The program storage device according to claim 19 wherein the ordering of said optimized lists is based on criterion regarding the translation to be performed on the data file.

21. (Previously Presented) The program storage device according to claim 20 wherein said criterion is defined by a received request for said data file.

22. (Previously Presented) The program storage device according to claim 17 further comprising the steps of:

accessing a portion of said optimized list ordered based upon the requested file format;

determining whether one or more of said listed file formats exists as one of said stored file formats; and

selecting from said optimized list the optimal file format that is determined to exists as a stored file format.

23. (Previously Presented) An apparatus for selecting a file format from a plurality of stored file formats for use in performing a translation from said selected file format to a requested file format, said apparatus comprising:

an interface element for receiving a request for a data file in a requested file format; and

translation optimization logic coupled to said interface for determining an optimal one of a plurality of file formats for use in performing said translation to said requested file format.